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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,187	09/17/2003	Michael J. Munchhof	PC25292A	9326

28523 7590 11/02/2006  
PFIZER INC.  
PATENT DEPARTMENT, MS8260-1611  
EASTERN POINT ROAD  
GROTON, CT 06340

EXAMINER

OWENS, AMELIA A

ART UNIT PAPER NUMBER

1625

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/667,187

Applicant(s)

MUNCHHOF ET AL.

Examiner

Amelia A. Owens

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14,15 and 19-22 is/are allowed.
- 6) ☒ Claim(s) 1,4,11 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 5-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. New claims 16-22 have been added. Claim 12 has been canceled. Claims 1-11,14-22 are pending.
2. The election of species regarding variable X is withdrawn. The restriction requirement between the compounds and methods of use is maintained. Applicants have canceled the method claims.
3. All claims presented in the amendment dated 8/10/2006 have been examined.

#### ***Claim Rejections - 35 USC § 112***

4. The rejection of claims 1-3 under 35 USC 112, 2<sup>nd</sup> paragraph is dropped as the claims have been amended.
5. The rejection of claim 1 under 35 USC, 1<sup>st</sup> paragraph, is dropped as the proviso has been removed from the claim.
6. Claims 1,16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim contains the terms 'mercapto', 'acid', 'ether' and 'ester', which are ambiguous. The metes and bounds of the terms cannot be ascertained. Mercapto is usually used to designate the presence of sulfur, not to name a substituent.

For example when defining R1, the list uses the terms 'or' and 'and' several times. This is improper Markush format.

#### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1,4,10,11,16-18 remain rejected under 35 U.S.C. 102(b) as being anticipated by Gellibert CA 137:169512. Applicant's remarks are noted and are not persuasive. The species according to the invention is RN 446852-67-1. Note R4 may be amine, R1 is 2-bromopyridyl (note R1 may be optionally substituted by halo), X is S. This species does not contain an amino

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substituted pyridyl but rather a bromo substituted pyridyl. It is the last appearing species in the abstract.

8. Claims 1,4,11,16 are rejected under 35 U.S.C. 102(a) as being anticipated by Ogura et al CA 138:338110 that teach species according to the invention. See RN 93366-61-1. Note R4 may be heterocyclic, R1 is pyridyl, and X is O.

9. Claims 1,4,11,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Robl CA 133:296436 that teach species according to the invention. See RN 300656-71-7. Note R4 may be aryl, R1 is pyridyl, and X is O.

10. Claims 1,4,11,18 are rejected under 35 U.S.C. 102(b) as being anticipated by Taurins CA 74:22749 that teach species according to the invention. See RN 30235-32-6; 30235-33-7j 30235-34-8. Note R4 may be amine, R1 is pyridyl, X is S. This compound is outside the proviso as the proviso specifically prevents R1 from being amino-substituted pyridyl not unsubstituted pyridyl.

11. Claims 1,4,11,18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gellibert CA 137:169511 that teach species according to the invention. See RN 446297-60-5; 446297-62-7. Note R4 may be amine, R1 is 1,5-naphthyridin-2-yl (note R1 may be unsubstituted or optionally substituted by alkyl), X is S.

12. Claims 1,4,11,18 are rejected under 35 U.S.C. 102(b) as being anticipated by Gelliart CA 137:169509 that teach species according to the invention. See for example RN 446301-78-6; 446301-80-0; 446301-82-2. Other species are depicted.

13. Claims 2,3,5-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 14,15,19-22 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Amelia A. Owens  
Primary Examiner  
Art Unit 1625